

Remarks

Claims 1-11 are pending. Claims 1-8 and 10-11 stand rejected. Claim 9 is objected to. The Applicants respectfully traverse the rejection and request allowance of claims 1-11.

Initial Comments

The Applicants filed a Notice of Appeal on July 1, 2003 in response to a final Office action dated April 1, 2003. The April 1, 2003 Office action rejected the claims based on the combination of U.S. Patent number 5,663,509 (Lew) and U.S. Patent number 5,394,758 (Wenger). Lew describes an inertia force flowmeter and Wenger describes a Coriolis flow meter. The Examiner combined the teaching of the flow tube shape in Lew with the Coriolis flow meter teaching in Wenger to reject the claims. The Applicants distinguished the claims of the pending application from Lew and Wenger in the Appeal Brief, and the Examiner responded with this Office action (dated 11-18-03). In this Office action, the Examiner rejects the claims based on the combination of U.S. Patent number 4,876,898 (Cage) and Lew. Like Wenger, Cage describes a Coriolis flow meter. The Examiner combined the Coriolis flow meter teaching in Cage with the teaching of the flow tube shape in Lew. The Examiner is relying on virtually the same Coriolis flow meter teaching from Cage to reject claims 1-6 and 10-11 as she used from Wenger in previously rejecting the claims. Thus, the Examiner has not provided any new teaching in this Office action in rejecting claims 1-6 and 10-11.

Consequently, the Examiner has not provided a sufficient new ground of rejection to warrant an Office action in response to the Appeal Brief. (*see* MPEP §1208). To issue an Office action in response to an Appeal Brief, a new ground of rejection is necessary. (*see* MPEP §1208). MPEP § 1208.01 provides that “[t]here is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection”. As previously stated, the Examiner is relying on the same teaching in Cage, for the rejection in this Office action, as she relied on in Wenger. The Applicants have already responded to the “basic thrust” of this rejection in the Appeal Brief by distinguishing the claims from Lew and Wenger. Thus, the Applicants submit that the Examiner has not provided a sufficient new ground of rejection.

Nonetheless, the Applicants respond to the Office action as follows, reiterating in

summary fashion, the distinguishing arguments made in the Appeal Brief.

§ 103 Claim Rejections

The Examiner rejected claims 1-6 and 10-11 under 35 U.S.C. § 103 in view of U.S. Patent number 4,876,898 (Cage) and U.S. Patent number 5,663,509 (Lew).

The Applicants first submit that Cage and Lew cannot be properly combined. The Examiner failed to show a suggestion or motivation to combine Cage and Lew to teach the Coriolis flowmeter of claim 1. Cage teaches a Coriolis flowmeter and Lew teaches an inertia force flowmeter. The Examiner failed to show what would motivate one skilled in the art to combine a Coriolis flowmeter with an inertia force flowmeter. Lew actually teaches away from Coriolis flowmeters, as is evident in: column 1, lines 50-63; column 1, line 63 to column 2, line 2; and column 8, lines 44-52. Because Lew teaches away from Coriolis flowmeters, the Applicants submit that the Examiner used hindsight after reading the invention to combine Cage and Lew. The Examiner cannot use the claimed invention as a template or blue print to piece together isolated references when making an obviousness rejection. *Sensonics Inc. v. Aerasonic Corp.*, 38 USPQ2d 1551, 1554 (CA FC 1996); *Ex parte Haymond*, 41 USPQ2d 1217, 1220 (Bd Pat App & Int 1996). The Examiner must consider the state of the art at the time of the invention and not use hindsight knowledge after reading the invention. *Sensonics Inc. v. Aerasonic Corp.*, 38 USPQ2d at 1554.

Secondly, the Applicants submit that Cage and Lew do not teach the following limitations of claim 1:

"a first flow tube having an inlet end and an outlet end, said first flow tube forming substantially a semicircle that begins at said inlet end of said first flow tube and ends at said outlet end of said first flow tube";

"a second flow tube having an inlet end and an outlet end, said second flow tube forming substantially a semicircle that begins at said inlet end of said second flow tube and ends at said outlet end of said second flow tube".

Neither Cage nor Lew teaches a Coriolis flowmeter having a flow tube *forming substantially a semicircle* that *begins* at an inlet end of the flow tube and *ends* at the outlet end of the flow tube as in claim 1. The Examiner admits that Cage does not teach a flow tube *forming substantially a semicircle* that *begins* at an inlet end of the flow tube and *ends* at the outlet end of the flow tube as in claim 1. (*see* Office action, page 3). However, the Examiner maintains that Lew teaches a flow tube that forms substantially a semicircle that begins at the inlet end of the flow tube and ends at the outlet end of the flow tube. The Applicants disagree.

The Applicants want to ensure that the Examiner is clear on the language in claim 1. Claim 1 describes a flow tube that forms substantially a semicircle that *begins* at an inlet end of the flow tube and *ends* at an outlet end of the flow tube. Thus, for Lew to teach the flow tube claimed in claim 1, Lew would have to teach a flow tube that is a semicircle (or substantially a semicircle) between an inlet end of the flow tube and the outlet end of the flow tube. Lew does not teach a flow tube having this shape.

In Lew, between the inlet end and the outlet end of the flow tubes, each flow tube includes a first straight portion, a first bending portion, a curved portion, a second bending portion, and a second straight portion. (*see* argument presented in the Appeal Brief submitted by Applicants). A flow tube having a curved portion, two straight portions, and two bending portions between its inlet end and its outlet end *cannot* form a semicircle. (*see* the flow tube in FIG. 5 in Lew).

The question thus becomes whether a flow tube having a curved portion, two straight portions, and two bending portions can be considered to form *substantially* a semicircle. Using the term "substantially" avoids strict adherence to the flow tubes forming "a semicircle that begins at said inlet end ... and ends at said outlet end". The term "substantially" allows the flow tubes of claim 1 to have a shape with *minor variations* from a semicircle from inlet end to outlet end. *See Verve LLC v. Crane Cams Inc.*, 65 USPQ 2d at 1054. The flow tubes in Lew have a shape which represents much more than a minor variation from a semicircle.

Consequently, claim 1 is novel and non-obvious over Cage and Lew. Dependent claims 2-6 and 10-11 are novel and non-obvious for similar reasons.

The Examiner further rejected claim 7 under Cage, Lew, and U.S. Patent number 5,394,758 (Wenger). The above remarks for claim 1 apply equally to this rejection of claim 7.

The Examiner further rejected claim 7 under Cage, Lew, Wenger, and U.S. Patent number 4,895,031 (Cae). The above remarks for claim 1 apply equally to this rejection of claim 8.

Allowable Subject Matter

The Applicants acknowledge the allowable subject matter in claim 9 as cited by the Examiner.

Conclusion

Based on the above remarks, the Applicants submit that claims 1-8 and 10-11 are allowable in addition to claim 9. There may be additional reasons in support of patentability, but such reasons are omitted in the interests of brevity. The Applicants respectfully request allowance of claims 1-11.

Any fees may be charged to deposit account 502622.

Respectfully submitted,

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